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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,459	01/09/2002	Francis Emmerson	367.40990X00	2640

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EXAMINER

CAPRON, AARON J

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 05/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/040,459	EMMERSON, FRANCIS
	Examiner	Art Unit
	Aaron J. Capron	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 25 June 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-17 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 and 6</u> .	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-10 and 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Menashe (U.S. Patent No. 5,586,937).

Referring to claim 1, Menashe discloses a client-server system (4:17-26) wherein the server comprises memory means for storing games data (Figure 1) and encryption means for encrypting the games data in accordance with one or more predetermined operational parameters (4:38-54), and transmission means for transmitting the encrypted games data to a client terminal (Figure 1), and wherein the client terminal comprises memory means for storing the received encrypted games data, processor means for executing the encrypted games data to provide an encrypted outcome, and transmission means for transmitting the outcome to the server (5:32-46 and 6:2-18).

Referring to claim 2, Menashe discloses the operational parameters including instructions on how to encrypt the outcome of the game (6:2-18).

Referring to claim 3, Menashe discloses the client terminal includes decryption means for decoding the encrypted games data (6:2-18).

Referring to claim 4, Menashe discloses the user plays the game and the terminal comprises encryption means for encrypting a result to be returned to the server (6:2-18)

Referring to claims 8-9, Menashe discloses the server on the basis of the encrypted outcome computes an updated result (6:2-7:14).

Claim 10 corresponds in scope to a method set forth for use of the method listed in the claims above and is encompassed by use as set forth in the rejection above.

Claims 13-17 correspond in scope to a server, computer program product, client-server system and method set forth for use of the method listed in the claims above and are encompassed by use as set forth in the rejection above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menashe in view of Khan et al (U.S. Patent No. 6,029,046; hereafter “Khan”).

Referring to claims 5-6, Menashe discloses a client/server system, but does not disclose a time limit for completing a game. However, Khan discloses that a player has a time limit to complete a game (2:13-29; 11:15-15:38 and 20:49-21:55). One would be motivated to combine the references in order to charge players for the amount of time played since the games are so expensive to purchase (Khan 1:33-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a time limit of Khan

into the gaming system of Menashe in order to charge players for the amount of time played since the games are so expensive to purchase.

Referring to claim 7, Menashe in view of Kahn disclose that if the game is reset then a null game is encrypted and returned to the server (2:66-3:5)

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menashe in view of LaDue (U.S. Patent No. 5,594,740).

Referring to claims 11-12, Menashe discloses a gaming device that downloads information from a server, but does not disclose a wireless handheld gaming device. However, LaDue discloses a wireless handheld device that downloads gaming information from a server (abstract and Figure 1). One would be motivated to combine the references in order to allow Menashe the capability of playing a game on a portable device. This offers players the chance to move around and continue playing a game. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the portable wireless gaming terminal of Ladue into Menashe's system in order to allow players the opportunity to move around and continue playing a game.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc  
May 14, 2003



S. THOMAS HUGHES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700